

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **MAIL STOP AF**
Koji Naito et al.)
Application No.: 09/820,688) Group Art Unit: 2625
Filed: March 30, 2001) Examiner: JAMES A THOMPSON
For: IMAGE PROCESSING)
APPARATUS, IMAGE FORMING)
APPARATUS, INFORMATION)
EMBEDDING METHOD, AND)
INFORMATION EMBEDDING)
PROGRAM)

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated December 27, 2007, Applicants hereby request a Pre-Appeal Brief Conference.

Claims 1, 3, 5 – 7, 9, 11 - 13, 15, 17 - 20, 22, and 24-28 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,577,746, hereinafter *Evans*, in view of U.S. Patent No. 5,987,127, hereinafter *Ikenoue*. Claims 4, 10, 16 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Evans* in view of *Ikenoue* and U.S. Patent No. 3,760,159, hereinafter *Davis*.

The Examiner continues to confuse information *about* the watermark with information that is *in* the watermark.

Claim 1 recites, among other things, a detecting unit that detects all pieces of additional information that are embedded in image data and a storage unit that stores the detected pieces of additional information in association with location information thereof. In the rejection, the Examiner alleges that column 2, lines 25 – 30 and 61 – 65, of *Evans* corresponds to the storage unit in claim 1 that stores the detected pieces of additional information in association with location information thereof, i.e., the location of the watermark.

However, in claim 1, the location information is information concerning the location of the watermark itself. This is clear from the remainder of claim 1, which further states that the embedding unit embeds a new piece of additional information including updated information into the image data at a location that does not overlap locations where the detected pieces of additional information are embedded, by referring to the stored location information.

Thus, the additional information is NOT the location information. The additional information is stored in association with the location information. In a preferred embodiment of the present invention, the "additional information" may include information such as the latest copy creation date, for example. See paragraph [0045].

It appears that the Examiner is taking the position that the claimed additional information corresponds to *Evans* watermark. The Examiner alleges that column 2, lines 25 – 30 and 61 – 65, of *Evans* describes the storage unit in claim 1 that stores the detected pieces of additional information in association with location information *thereof*, i.e., the location of the watermark. However, in *Evans*, the watermark contains image data, and the image data from the watermark is used to form an image in the document to be reproduced. The "location information" referred to in *Evans* concerns the location (size, rotation, etc.) where the imported image is to be inserted into the original image. It does not concern the location of the watermark itself. Accordingly, *Evans* does not teach or suggest the claimed storage unit that stores the detected pieces of additional information in association with location information *thereof*. The "location" referred to in *Evans* is the location where image data contained in the watermark is to be inserted into the document. However, that section of *Evans* does not indicate that the watermark includes storage information concerning the location of the watermark.

With regard to column 2, lines 62 – 65, of *Evans*, Applicants submit that this teaches that the watermark detector discerns the placement of the imported image within the original image, not the location of the watermark itself. Accordingly, *Evans* does not teach or suggest the claimed storage unit. Neither *Evans* nor *Ikenoue* discloses that subject matter, either separately or in combination.

At the end of page 3 of the December 27, 2007 Official Action, the Examiner relies upon *Ikenoue* for an alleged teaching of embedding a new piece of additional information including updated information into first image data at a location that does not overlap locations where the detected pieces of information are embedded.

However, the claim language states that:

(2) embeds, when the judgment result of the analyzing unit is negative, a new piece of additional information including updated information into the image data at a location that does not overlap locations where the detected pieces of additional information are embedded, **by referring to the stored location information**, the updated information being equivalent to the predetermined information.

However, in the Advisory Action, the Examiner alleges that *Evans* teaches the location where the additional information is stored in the original image. However, as set forth above, *Evans* does not concern the location of the watermark, i.e., the location of where the additional information is stored in the original image. And, the Examiner does not allege that *Ikenoue* teaches using the stored location information to determine where to embed the new piece of additional information.

Accordingly, neither *Evans* nor *Ikenoue* teaches using the stored location information to determine where to embed the new piece of additional information. Neither *Evans* nor *Ikenoue* discloses that subject matter, either separately or in combination.

There is no substitution of the watermark in *Evans*.

At the paragraph bridging pages 2 and 3 of the December 27, 2007 Official Action, the Examiner appears to argue that the *Evans* watermark is updated. However, the portion of *Evans* quoted by the Examiner (column 3, lines 47 - 52) clearly states that it is the ultimate picture being reproduced, not the watermark, that is updated ("...for a **picture** to be updated..."). See also, column 3, lines 39 - 42, "watermarked-**based** enhancement or upgrading". In other words, the watermark is used to update the image, the watermark itself is not updated. Using a watermark to update an image does not mean that the watermark itself is updated.

In the Advisory Action dated May 29, 2008, the Examiner alleges that column 2, lines 7 - 9 and 25 - 35 of *Evans* demonstrates "that the detected watermark (31), if

found in the remote server database, is substituted with a pristine copy of the watermark (38) which is used for photocopying." However, the Examiner has misinterpreted *Evans*. First, neither of reference numerals (31) and (38) relates to the watermark. They both relate to the picture or image. In fact, in the example discussed, the picture (31) is the object (38). There is no discussion of updating or changing the watermark. *Evans* merely indicates that the watermark is used to update the image.

Conclusion:

Accordingly, Applicants submit that:

Evans does not teach or suggest the claimed storage unit;

Evans does not teach that the additional information (e.g., the watermark) is updated; and

neither *Evans* nor *Ikenoue* teaches using the stored location information to determine where to embed the new piece of additional information.

For at least those reasons, the alleged combination of *Evans* and *Ikenoue*, as proposed by the Examiner, does not disclose the combination of features defined by Claim 1, and Claim 1 is allowable.

Claims 7, 13, 20 and 26-28 are allowable for similar reasons as Claim 1 with regard to similar claim language.

Claims 3, 5, 6, 9, 11, 12, 15, 17-19, 22, 24 and 25 are allowable at least by virtue of their dependence from allowable independent claims.

With regard to claims 4, 10, 16 and 23, *Davis* does not overcome the deficiencies of the rejections of the independent claims from which Claims 4, 10, 16 and 23 depend. For at least that reason, they are allowable too.

Based on the above-observations, it is respectfully requested that all the rejections set forth be reconsidered and withdrawn. Should any questions arise in connection with this application, or should the Examiner feel that a teleconference would be helpful in resolving any remaining issues pertaining to this application, the undersigned requests that he be contacted at the number indicated below.

Respectfully submitted,

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